



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,907	12/22/2000	Takahiro Endo	1344.1052 (JDH)	6594

21171 7590 08/20/2007
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

08/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/741,907

Applicant(s)

ENDO ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6, 8, 9, 11, 13, 15, 17, 19, 21-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 8, 9, 11, 13, 15, 17, 19, 21-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed June 7, 2007. Applicant amended claims 1, 8, 9, 15, 21-23 and 25. Claims 7, 14 and 18 have been canceled. Claims 1, 2, 4, 6, 8, 9, 11, 13, 15, 17, 19, 21-23 and 25 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6, 8, 9, 11, 13, 15, 17, 19, 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. JP 11-242714 further in view of Stanbach, Jr. et al. (US 6,449,657).

Regarding claims 1, 2, 4 and 6, Sugimoto teaches means for sending a card attached with an optional message to a specified addressee; means for inputting a preference trend of addressee. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient (addressee) creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; means for selecting advertisements suitable for the preference trends of addressee; and means for selecting advertisements suitable for the preference trends of sender; means for making the card

Art Unit: 3622

sending client select one piece of advertisement from the plurality of advertisement displayed; storing card sending history; frequency counting means; means for sending card attached with the advertisement ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see pp. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto also teaches sender selects a specific course; the sender can also receive a gift selected by the advertising company paying for this course, for example, a golf club manufacturer can have several golf-related gifts, and a car manufacturer can have several car-related gifts, an opportunity for soliciting ads (also called acceptance ads) which is a form of advertising (gift descriptions) that participants ask to see and show interest in (see also page 17); *adding advertisement identification information for identifying non-visual advertisement information to said card; and outputting non-visual advertisement information (description of the gift) (see page 37)*. Sugimoto however failed to explicitly disclose wherein a providing target (target audience or criteria) of the advertisement information, has been preliminarily determined by the advertisement provider upon selection of the advertisement information. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the

Art Unit: 3622

time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target, which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).

Regarding claims 8, 9, 11 and 13, Sugimoto teaches means for sending card attached with optional message to specified addressee; means for inputting preference trends. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card means for selecting advertisement; means for presenting advertisement; selecting advertisement information suitable for the addressee; selecting advertisement information suitable for the sender; selecting and presenting plurality of advertisements; card sending client select one of the advertisement; a card sending history; changing additional information ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see pp. 16 lines 24-32 (par. 2), pp. 17 par. 2&3), and

Art Unit: 3622

from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17); *adding advertisement identification information for identifying non-visual advertisement information to said card; and outputting non-visual advertisement information (description of the gift) (see page 37)*. Sugimoto however failed to explicitly disclose wherein the providing target (target audience or criteria) is preliminarily determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of an ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminarily selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).

Art Unit: 3622

Claims 15, 17 and 19 are rejected as stated above in claims 8-15.

Regarding claims 21-23, Sugimoto teaches sending a card attached with an optional message to a specified addressee; input preference trends of the addressee. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; selecting advertisement information to fit the preference trends of the addressee and adding the advertisement information; inputting preference trends of sender; selecting advertisement to fit the sender's preference trends and presenting the advertisement to sending client (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient filled out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto does not specifically teach wherein the providing target (target audience or target criteria or as indicated by applicant's argument "a target market") is preliminary determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a

Art Unit: 3622

plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). *Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).*

Regarding claim 25, Sugimoto teaches inputting a preference trend of addressee (sender selecting specific course for selecting advertisement/gift, that he/she thinks the recipient (addressee) will like (see page 16)); preliminarily determining preference trends of a providing target of the advertisement by an advertisement provider. Sugimoto teaches selecting the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17); selecting by advertisement provider advertisements suitable for the preference trends of addressee (based on the course selected by the sender, see page 17); selecting by card sending client at least one piece of advertisement from the plurality of advertisement displayed; (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto however failed to explicitly teach wherein a providing target (target audience or criteria) of the advertisement information, has been preliminarily determined by the

Art Unit: 3622

advertisement provider upon selection of the advertisement information. Stanbach teaches the (*target*) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).

Based on Applicant's argument that the additional information is related to discount, Examiner presents the following rejection.

Claims 1, 2, 4, 6, 8, 9, 11, 13, 15, 17, 19, 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. JP 11-242714 further in view of Stanbach, Jr. et al. (US 6,449,657) and further in view of Kamakura et al. (US 6,076,101).

Regarding claims 1, 2, 4, 6, 8, 9, 11, 13, 15, 17, 19, 21-23 and 25, Sugimoto teaches means for sending a card attached with an optional message to a specified addressee; means for inputting a preference trend of addressee. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; means for selecting advertisements suitable for the preference trends of addressee; and means for selecting advertisements suitable for the preference trends of sender; means for making the card sending client select one piece of advertisement from the plurality of advertisement displayed; storing card sending history; frequency counting means; means for sending card attached with the advertisement ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17); *adding advertisement identification information for identifying non-visual advertisement information to said card; and outputting non-visual advertisement information (description of the gift) (see page 37)*. Sugimoto does not specifically teach wherein a providing target (target audience or criteria) of the advertisement information, has been preliminarily determined by the advertisement provider upon selection of the advertisement information. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to

Art Unit: 3622

col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target, which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). *Kamakura teaches changing additional information based on the number of time a card can is sent (see abstract, col. 3 lines 3-63). It would have been obvious to one of the ordinary skill in the art at the time of the invention to implement Kamadura's points in Sugimoto's email system, which provides predetermined points every time a recipient reads the message which increases the utilization frequency of the card sending service.*

Response to Arguments

Applicant's arguments filed June 7, 2007 have been fully considered but they are not persuasive.

Applicant argues that the claim recites changing additional information to be added to said card based on the utilization frequency" rather than simply changing additional information based on the utilization frequency as asserted by the Office action. Applicant further asserts that

Art Unit: 3622

Sugimoto sets conditions on the sender not on the card. However, according to the claim there is no step of adding the information on the card. The claim recites changing additional information to be added to said card, however does not recite the step of adding the information to the card, which is just an intended purpose of the changing the information.

Applicant also argues the claim recites "preference trends" not target age, target sex or target income contrary to the assertion in the Office action. Examiner would like to point out that applicant's argument was regarding the providing target not the preference trends. Applicant's previous argument stated, "Neither Sugimoto nor Stanbach teach, disclose, or suggest, "wherein a providing target of the advertisement information has been preliminarily determined by the advertisement provider upon selection of the advertisement information," as recited in claim 1. No *providing* target is mentioned in either Sugimoto or Stanbach at all".

Applicant's argument regarding the non-visual advertisement states that according to the claimed invention the addressee who has received a card can use a non-visual advertisement information such as music, if he or she inputs the advertisement identification information. Examiner would like to point out that the claim does not recite what information is displayed that allow the user to input the information into a system of a particular shop. Just displaying non-visual advertisement information does not mean the information could be used or would allow a user to use it with a system in a shop. Applicant's disclosure also discloses non-visual advertisement information for identifying non-visual advertisement information may be added to the card, and the non-visual advertisement information then output based on the advertisement identification information. The disclosure teaches even if there is advertisement information such as music or images which cannot be shown with a card, the addressee can use this, and

Art Unit: 3622

advertisement information which cannot be transmitted in the current publicizing format, can also be provided. Even applicant's disclosure does not teach what information is displayed if advertisement information such as music or images cannot be shown with a card. So Examiner considers a description of a product, instead of the image, as non-visual advertisement of the product such as music.

Applicant argues that Sugimoto pays no attention to what the preference trends of the addressee might be at all let alone selecting advertising information based upon them. The argument has already been addressed in the previous Office action. As indicated before, Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; selecting advertisement information to fit the preference trends of the addressee and adding the advertisement information; inputting preference trends of sender; selecting advertisement to fit the sender's preference trends and presenting the advertisement to sending client (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Applicant argues that in Sugimoto since the free gift might be acquired by both the sender and the receiver, as a team, the sender's personal gift preference will surely take precedence over whatever the sender might think the receiver might like. According to applicant's invention it is the sender that inputs the addressee's attribute in order for the applicant's system to realize the preference trend and for the system to retrieve advertisement information thought to be of interest to the addressee. Therefore, the advertisement is selected

Art Unit: 3622

based on what the sender inputs, same as Sugimoto. Applicant is ignoring the fact that Stanbach demographic profile includes user lifestyle preference and favorites (see col. 11 lines 10-22, col. 19 lines 4-14 and figure 10 table 1064) and the advertisement is selected based on the preference (lifestyle preference and favorites) of the recipient (addressee). Examiner is aware that Stanbach also teaches another embodiment, wherein all or a portion of the advertisements can be selected without regard to demographic and/or personal information-of the intended recipient 720 or the fact that when selecting an advertisement, demographic information pertaining to the intended recipient 720 is queried to select the demographic profile snapshot best matching the intended recipient 720. However Applicant seems to ignore the fact that the demographic profile of Stanbach includes favorite or lifestyle preference. Stanbach teaches “(i)n one embodiment, a demographic profile corresponding to the recipient address 720 is established by querying the database 744. The query can be performed on a favorites table, or a client table, or some other table comprising demographic information on the intended recipient (e.g., favorites table 964 or client table 912 in FIG. 9). The demographic profile generated on the intended recipient 720 is then used to create a sub-set of advertisements from an ads table (e.g., ads table 960 in FIG. 9). This sub-set of advertisements from the ads table is particularly focused towards the demographic profile matching the intended recipient 720”.

In regard to Kamakura, Applicant argues that Kamakura does not either, and thus cannot make up for the deficiencies of either Sugimoto or Stanbach with respect to the claimed invention. Thus, even if Sugimoto, Stanbach and Kamakura were combined, as proposed in the Office Action, the claimed invention would not result. Examiner relied on Kamakura since

Applicant argued that the additional information, i.e., a discount coupon ticket to be added to the card, may be changed based on the measured utilization frequency of the card.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yehdega Retta
Primary Examiner
Art Unit 3622